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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* TIMOTHY A. KENDALL, MATTHEW R. COHLER, MARK E. ZUCKERBERG, YUN-FANG JUAN, ROBERT KANG-XING JIN, JUSTIN M. ROSENSTEIN, ANDREW G. BOSWORTH, YISHAN WONG, ADAM D'ANGELO, and CHAMATH M. PALIHAPITIYA

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Appeal 2015-008182  
Application 12/853,241  
Technology Center 3600

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Before ANTON W. FETTING, SHEILA F. McSHANE, and MATTHEW S. MEYERS, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

The Appellants request rehearing of our Decision (hereinafter “Dec.”), entered April 21, 2017, in which we affirmed the Examiner’s rejection of claims 1–3, 5, 6, 8–11, and 13–20 under 35 U.S.C. § 101 (Request for Rehearing, filed June 18, 2017, hereinafter “Req. Reh’g”).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision, to responses to a new ground of rejection designated pursuant to § 41.50(b), or presentations

of new arguments based upon recent decisions of the Federal Circuit. 37  
C.F.R. § 41.52.

### ISSUES ON REHEARING

The Appellants argue that in our Decision we failed to consider the issues in this case in light of recent decisions from the Federal Circuit, namely, *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) (“*Enfish*”), *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) (“*McRO*”), and *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) (“*BASCOM*”). Req. Reh’g 2. The Appellants request that we perform a review under the more recent case law and reverse our decision. *Id.*

### DISCUSSION

In their Request, the Appellants argue that in *Enfish*, the Federal Circuit found that the claims at issue were not directed to “general-purpose computer components [that] are added post-hoc to a fundamental economic practice or mathematical equation,” but rather are “directed to a specific implementation of a solution to a problem in the software arts.” *Id.* at 2–3 (citing *Enfish*, 837 F.3d at 1399). The Appellants assert that, as in *Enfish*, the claims at issue are more than merely adding of general-purpose components to the economic practice of advertising or to a method of organizing human activity because, for instance,

Claim 1 very specifically defines a step-by-step method starting with receiving an ad request and the details of the request, all the way through logging information, generating stories, receiving bids, and selecting stories to be accelerated. . . [and] it includes another concept unique at the time in this context of computing

affinity scores for users and applying those scores in the acceleration of stories so the advertiser also gets the benefit of sponsoring a story for a user from a close friend rather than a distant connection.

Req. Reh’g 4.

The Appellants contend that we did not consider all the steps in “the overall context of providing organic stories in a social networking context. This is not a mere adding of general-purpose computer components post-hoc to a claim to the fundamental economic practice of advertising,” and thus not directed to an abstract idea. Req. Reh’g 9. It is also alleged that claim 1: “defines a step-by-step method starting with receiving an ad request and the details of the request, all the way through logging information, generating stories, receiving bids, and selecting stories to be accelerated. . . [and] includes another concept unique at the time in this context of computing affinity scores for users and applying those scores in the acceleration of stories so the advertiser also gets the benefit of sponsoring a story for a user from a close friend rather than a distant connection.” *Id.* at 4.

The Appellants additionally argue that in *Enfish* the Federal Circuit found that the claims at issue were an improvement of existing technology based on the specification’s teachings where the invention achieved benefits that the existing technology lacked. Req. Reh’g 4 (citing *Enfish*, 822 F.3d at 1336). The Appellants assert that “the claimed invention achieves benefits that existing attempts do not have by allowing advertisers to utilize connections among members of a social networking website to sponsor posts by those users and thus provide a more natural way of introducing users to brands.” *Id.* at 5 (citing Spec. ¶ 5).

Turning to *McRO*, the Appellants argue that the independent claims at issue “include specific limitations that prevent preemption of all techniques for organizing human activity or even for providing social endorsements,” similar to *McRO*’s claims, also having non-preemptive limitations. Req. Reh’g 5 (citing *McRO*, 837 F.3d at 1315). The Appellants allege that, although the Board found that preemption is not dispositive as to a finding of patent eligibility, the lack of preemption “strongly suggests” that the claims are patent eligible.<sup>1</sup> *Id.* at 6. The Appellants also contend that, similar to *McRO*, “the claimed method does not merely automate an existing process that has historically been performed by humans using the steps humans would normally perform in that process, and then add a computer to that process,” and that “the claim are steps that only a computer would perform in that particular way and in that particular ordering.” *Id.* at 8–9. As an example, Appellants argue, “a human providing a celebrity endorsement would not log actions taken by connections over a period of time or generate a plurality of stories about those actions, and then collect bid amounts, compute affinity scores, and use this to accelerate certain stories.” *Id.* at 10. The Appellants allege that, in addressing whether the claims are “significantly more,” our assessment of pre-Internet advertising practices did not consider how print ads might be accelerated over other stores based on bid amounts and affinity scores between two users. *Id.* The Appellants allege that the insert in a school alumni organization newsletter did not

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<sup>1</sup> Although the Request states that “Though the Board states that pre-emption is dispositive as to a finding of patent eligibility . . . ,” “it appears that this statement is an inadvertent error, and the statement is assumed to be that “pre-emption is not dispositive.” See Req. Reh’g 6.

consider all the steps of the claims that include matching an advertisement request that includes information related to actions without the need of a human newsletter drafter, or logging information related to actions taken, or computation of an affinity score, with acceleration of stories. *Id.* at 10–11. Additionally, it is alleged that under the claims, there are “different stories for different viewing users because different viewing users can have different connections who have performed different actions,” with “accelerat[ion] [of] different stories (or accelerat[ion] [of] same stories in different ways) for different viewing users because affinity scores of different viewing users can be different.” *Id.* at 11. The Appellants contrast this with a human newsletter drafter who “typically would generate stories that seem interesting to all or most alumni receiving the newsletter.” *Id.*

The Appellants additionally contend that *BASCOM* is instructive because the particular arrangement of the specific limitations concerning filtering content on the Internet was deemed “something more” under the second step of *Alice*. Req. Reh’g 6–7. It is alleged that, similar to *BASCOM*, the instant claims supply “an unconventional and non-generic” application of generating and selecting sponsored stories” and “a specific, discrete implementation” that includes the logging, generating stories, matching advertisement requests, computing affinity scores, selecting stories, and accelerating them, with story display steps. *Id.* at 8.

We find that, in light of more recent case law and the Appellants’ arguments on their application, there was no misapprehension or issues overlooked in the Decision. The Appellants argue that the claims represent more than adding computer components to social endorsements, however, all the method steps are directed to communicating a social endorsement—

which is for the purposes of advertising a product and/or selling advertising, which are fundamental, long-standing, and well-known economic practices. The issues that the Appellants argue with respect to similarities to *McRo* and *BASCOM* are that the instant claims are specific implementations in the software arts, and specific techniques for that implementation. Underlying the argument is the allegation that specific steps of the claims are steps that a computer would perform in a certain order and this differentiates them from the steps humans would normally perform, with the Appellants focusing on the steps of “logging” information, “generating” the “sponsored story,” and “computing an affinity score” with associated “acceleration” of story display. Examining the elements of the claims, the Specification broadly describes communications of the invention in the context of a social network as follows

Persons skilled in the relevant art can appreciate that many modifications and variations are possible in light of the above disclosure. For example, although the foregoing embodiments have been described in the context of a social network website, it will appear to one of ordinary skill in the art that the invention may be used with any electronic social network service, even if it is not provided through a website. Any computer-based system that provides social networking functionality can be used in accordance with the present invention even if it relies, for example, on e-mail, instant messaging, or other form of electronic communications, and any other technique for communicating between users. The invention is thus not limited to any particular type of communication system, network, protocol, format or application.

Specification (“Spec.”) ¶ 102.<sup>2</sup>

The Appellants do not allege that the communications techniques of the social network, which extend to e-mail and “any other technique for communicating between users,” are inventive in and of themselves. The Specification states that the invention is generically related to “social networking websites and other websites in which users can form connections with each other,” and refers to “[s]ocial networks, or social utilities that track and enable connections between members (including people, businesses, and other entities).” Spec. ¶¶ 2, 3. As such, a “social network” serves to track and enable connections between users. Thus, the school alumni organization analogized in the Decision was fairly viewed as a social network that would serve to facilitate communications, as well as track and enable connections amongst its alumni users. *See* Dec. 10–11.

We do not agree with the Appellants’ argument that the claimed method does not automate an existing process that has historically been performed by humans, and is a computer-specific method only. More specifically, the Appellants’ differentiation argument that feeding a sponsored story without the need of a human newsletter drafter is not persuasive. Claim 1 recites the selection of data related to user actions that is used to generate a “sponsored story,” for the feed to viewing users. “Sponsored stories” include, [as argued by Appellants], include messages such as “your friend John likes Nike,” which is a simple notification

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<sup>2</sup> Herein, we refer to the version of the Specification published on February 3, 2011, as US Publication No. 2011/0029388 A1, which is the same as the originally-filed Specification filed on August 9, 2010, except for some paragraph numbering variations.



message. *See* Dec. 5; App. Br. 11. Creating notice-type advertisements is not unique to the Internet or computers, but rather is used, more generally, in targeted marketing and advertising. As discussed in the Decision, we view this type of “story” as similar to an insert in an alumni newsletter that lists alumni who have acted to sign up for a trip (i.e., positive responses of other connected alumni) that is being advertised. *Id.* at 10–11. Similarly, different users (recipients) can be sent newsletters with the inserts specific to signed-up individuals having varying connections, i.e., those who were in the same graduating class or who had been on previous trips with the respective users.

Considering the other steps of the claims in toto, none perform anything beyond well understood, routine, and conventional activities. There is no showing or rationale provided that the use of a computer to generate a “story,” that is, simply reporting an action to another, would be beyond routine use of a computer as a tool to automate regular activity and “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (citing *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2359 (2014)). As to another alleged differentiation step that the Appellants argue, that is, that under the claims information related to user’s actions is logged, there is no rationale provided as to why logging of actions consisting of recording actions (for instance, noting on paper that an individual has signed up for a trip, for instance), would not be routine, short of the logging being performed automatically by computer. The Appellants do not allege that the

calculation of an “affinity score”<sup>3</sup> was not known or is inventive in and of itself. Because an “affinity score,” may be based upon any user action, interest, or characteristic, this step would include, for instance, evaluating whether to “accelerate” a “story” by, for instance, assessing whether to preferentially send an alumna newsletter targeted to alumna in the same class with other alumna (users) who have signed up for a trip and who have been on previous trips with the users. *See* Spec. ¶ 60. Similarly, the Appellants do not allege that the steps of bidding or using the bids to select advertising stories to display was not previously known or is inventive. These steps add nothing that “amounts to significantly more than a patent upon the [abstract idea] itself.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014); *see Synopsys, Inc. v. Mentor Graphics Corporation*, 839 F.3d 1138, 1152 (2016). Moreover, merely combining a series of abstract ideas does not render the combination any less abstract. *Cf. Shortridge v. Found. Constr. Payroll Serv., LLC*, No. 14-CV-04850-JCS, 2015 WL 1739256 (N.D. Cal. Apr. 14, 2015), *aff’d*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

Therefore, taking the claim elements separately—logging information relating to actions performed by social networking system users, generating

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<sup>3</sup> The Specification discloses that an “affinity score” “takes into account the set of affinities for the particular member for each type of data field that is in a candidate story,” where an “affinity” “may merely be a correlation between something in the candidate story and some information stored in connection with that member, whether is an action taken by the member, a communication involving the member, a characteristic, feature or expressed interest in the member's profile.” Spec. ¶ 60. No quantitative formula for an “affinity score” is provided in the Specification.

stories, computing affinity scores of the story for the viewing user, bidding the story, and providing the story for display—the computer functions performed in all the steps of the process are conventional. And when considered as a combined ordered series of steps, the combination adds nothing that is not also present when the steps are considered separately. Thus, the claims at issue lack “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself,’” (*Alice*, 134 S. Ct. at 2355), or represent “a result that overrides the routine and conventional” aspects of the technology (*DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258–59 (Fed. Cir. 2014)). Rather the claims “simply instruct the practitioners to implement the abstract idea . . . on a generic computer.” *Alice*, 134 S. Ct. at 2359.

Appellants overstate the alleged similarities of the claims at issue to *Enfish*. The claims at issue in *Enfish*, and the thrust of its analysis, were directed to specific improvements in the way that computers operate, which is not at issue here.<sup>4</sup> *See Enfish*, 822 F.3d at 1336. Nor do the claims solve a problem unique to the Internet. *See DDR*, 773 F.3d at 1257.

As such, considering all the claimed steps, we find no misapprehension or oversight in our Decision.

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<sup>4</sup> “[T]he key question is ‘whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.’” *Visual Memory LLC v. NVIDIA Corp.*, No. 16-2254, 2017 WL 3481288, at \*3 (Fed. Cir. August 15, 2017) (quoting *Enfish*, 822 F.3d at 1335–36).

### CONCLUSION

In view of the foregoing, we are not persuaded of reversible error in the Examiner's rejection, or that we misapprehended or overlooked any points of law or fact in rendering our decision. We therefore deny the Appellants' request to modify our Decision and the Examiner's rejection remains affirmed.

### DECISION

Although we have reconsidered certain aspects of our original Decision in light of the Appellants' arguments, we decline to modify our original Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED